RANSOME / TEMPIL INC.

v.

ROMAR POSITIONING EQUIPMENT PTE. LTD. & ANOR.

HIGH COURT, SINGAPORE
CHAO HICK TIN J
[SUIT NO. 705 OF 1990]
30 APRIL 1991

TRADEMARKS: *Judged solely by the eye - Appearance of articles - Regardless of way they are made or operate - Industrial drawings not connected to design - UK Patents & Designs Act 1907.*

CIVIL PROCEDURE: *Action for infringement of copyright - Further and better particulars sought by defendants prior to filing of defence - Circumstances under which Court will order these particulars to be provided - Set out in claim - Prejudice or embarrassment - Whether facts or evidence - Rules of Supreme Court 1970 [Sing], O. 18 r. 2(5).*

The plaintiffs P commenced proceedings to restrain D1 and D2 from infringing P's copyright in the artistic works of the industrial drawings of P's industrial equipment and from reproducing for sale P's industrial equipment. P claim as owners of copyright of the industrial drawings as these drawings were designed by their employees.

The defendants applied for further and better particulars without first filing a defence. This application was refused by the Assistant Registrar; hence this appeal.

P contends that under O. 18 r. 12(5) of the RSC, an order for further and better particulars shall not be made before the service of the defence unless the Court was of the opinion that the order is necessary or desirable to enable the defendant to plead or for some other special reason.

Held:

[1] As P's statement of claim clearly sets out the basis upon which P claims ownership of the copyright in the industrial drawings, there is no reason why the defendants could not have filed their defence before asking for particulars; neither has it been shown that the defendants would be prejudiced or embarrassed in its pleadings if particulars were not furnished before the defence.

[2] The particulars sought by the defendants as to the details of the authors who designed the industrial drawings and the matters relied upon by P to establish that they were the owners of the alleged copyright in the industrial drawings relates to evidence which should only be given at the trial; what needs to be pleaded are facts and not evidence.

[3] Under the UK Patents & Designs Act 1907, only features of shape, configuration, pattern or ornament applied to any article by an industrial process or means, being features which in the finished article appeal to and are Judged solely by the eye, are capable of being registered as a design. The industrial equipment in question which are reproduced from the industrial drawings are purely functional equipment used for heavy industrial welding, they do not have eye appeal and have nothing to do with designs which are registrable under this Act.

[4] The defendants are not entitled to the particulars of the grounds and headings under which P is claiming additional damages as:

(a) these particulars are set out in the statement of claim and it is clear that P are asking for additional damages because the infringements by the defendants were and are not accidental or innocent but deliberately done with a view of making profit at P' expense and

(b) there is no need for P to furnish such particulars - see *Broome v. Cassell & Co. Ltd.*

[Defendants' appeal dismissed.]

Cases referred to:
Broome v. Cassell & Co. Ltd. [1971] 2 QB 354
PJ Holdings Australia Pty. Ltd. v. Hughes [1979] ALR 538
Pugh v. Riley Cycle Co. Ltd. [1912] 1 Ch 613
Roban Jig & Tool Co. Ltd. v. Taylor [1979] FSR 130

Legislation referred to:
Copyright Act (Cap 63) [Sing], ss. 30(6), 130(1), 210, 211
Copyright (International Protection) Regulations 1987 [Sing], r. 6
Rules of Supreme Court [UK], O. 18 rr. 7(1), 12(5)

Other sources referred to:
Atkin's Encyclopedia of Court Forms in Civil Proceedings 1990, Vol. 12 p. 535

For the plaintiffs - Cecilia Thomas
For the defendants - James Chia

JUDGMENT

Chao Hick Tin J:

The plaintiffs are a corporation incorporated in the State of Delaware, USA. The business of the plaintiffs is in the design, manufacture and selling of heavy industrial equipment used in welding and other industrial applications.

The defendants are companies incorporated in Singapore. The 1st defendant is in the business of manufacturing and repairing specialised machinery. The business of the 2nd defendant includes manufacturing machine tools and accessories (for example, small cutting tools, precision measuring tools or tool holders).

In this action the plaintiffs seek to restrain the defendants from infringing their copyright in the artistic works of the industrial drawings of the plaintiffs' industrial equipment and to restrain the defendants from reproducing for sale the plaintiffs' industrial equipment.

On the filing of the writ in this action on 19 April 1990, the plaintiffs obtained an interim injunction and Anton Piller order against the defendants. This interim order was eventually discharged in 1 November 1990. There is no need for me to deal with those proceedings here as the matter that came before me was an appeal against a decision of the learned Assistant Registrar refusing the defendants' application for further and better particulars. I dismissed the appeal and now give my reasons.

In the statement of claim filed on 18 June 1990, the plaintiffs aver that they are designers, manufacturers and vendors of these industrial equipment:

Rotators

(a) Rotator Model A consisting of power and idler rolls;
(b) Rotator Model AA consisting of power and idler rolls;
(c) Rotator Model AAA consisting of power and idler rolls;
(d) Rotator Model B consisting of power and idler rolls;
(e) Rotator Model C consisting of power and idler rolls;
(f) Rotator Model D consisting of power and idler rolls;
(g) Rotator Model E consisting of power and idler rolls;

Manipulators

(h) Manipulator Model 66;
(i) Manipulator Model 99;
(j) Manipulator Model 1212.

The plaintiffs also state that the two defendants are manufacturing and selling these industrial equipment:

Rotators

(a) Rotator Model A5R consisting of power and idler rolls;
(b) Rotator Model A10R consisting of power and idler rolls;
(c) Rotator Model A20R consisting of power and idler rolls;
(d) Rotator Model B30R consisting of power and idler rolls;
(e) Rotator Model C60R consisting of power and idler rolls;
(f) Rotator Model D90R consisting of power and idler rolls;
(g) Rotator Model E120R consisting of power and idler rolls.

Manipulator

(h) Manipulator Model 2020 STD;
(i) Manipulator Model 3030 STD;
(j) Manipulator Model 4040 STD.

The plaintiffs claim that they were and are at all material times the owners of the copyright subsisting in the artistic works comprised in the industrial drawings on the basis of which the plaintiffs' rotators and manipulators are manufactured. They also claim to be copyright owners of a certain warranty statement. The plaintiffs state that the industrial drawings were designed by "members of the plaintiffs' design office all of whom were at all material times employed by the plaintiffs. " Accordingly, such artistic works are protected by virtue of ss. 210 and 211 of the Copyright Act (Cap. 63) and r. 6 of the Copyright (International Protection) Regulations 1987.

In para. 11 of the statement of claim, the plaintiffs claim that they have sold large quantities of their rotators and manipulators, both in Singapore and internationally, as a result of which they have "established an excellent reputation in Singapore and internationally."

Under para. 15 of the statement of claim, the plaintiffs allege that the defendants have knowingly and without consent infringed the plaintiffs' copyright by, *inter alia*, reproducing the plaintiffs' industrial drawings or the plaintiffs' said rotators and manipulators and offering the defendants' rotators and manipulators for sale. The statement of claim then goes on to describe how, through private investigators, the plaintiffs have obtained evidence of the defendants' infringing acts and how through legal processes (search warrants and Anton Piller order) the defendants' rotators and manipulators were seized by the police and various items obtained by the plaintiffs from the defendants' premises.

In the same para. 15 of the statement of claim the following particulars, *inter alia,* are given:

> h. The plaintiffs have inspected the 1st and 2nd defendants' said industrial drawings and the 1st and 2nd defendants' said rotators and manipulators seized under the 1st and 2nd warrants and the said order of Court and compared the same with the plaintiffs' said industrial drawings and the plaintiffs' said rotators and manipulators. The plaintiffs observed that the 1st and 2nd defendants' said industrial drawings and the 1st and 2nd defendants' said rotators and manipulators are the same or substantially the same as the plaintiffs' said industrial drawings and the plaintiffs' said rotators and manipulators. The particulars of similarities between the plaintiffs' said rotators and manipulators and the 1st and 2nd defendants' said rotators and manipulators are listed out in Schedule 'A' attached to this statement of claim and form part of this statement of claim;
>
> k. Whilst in the employment of SSH the said Johnathan Lim Keng Hock had access to the plaintiffs' manufacturing technology for the manufacture of the plaintiffs' said rotators and manipulators when he participated in a course organised by the plaintiffs' at the plaintiffs' factory in the United States of America.
>
> l. Whilst in the employment of SSH the said Johnathan Lim Keng Hock had access to confidential information belonging to the plaintiffs regarding the plaintiffs' said industrial drawings, the plaintiffs' sales brochures the plaintiff's said rotators and manipulators, the plaintiffs' customer list for Singapore and the surrounding regions and the plaintiffs' said manufacturing technology;
>
> m. Upon the resignation of the said Johnathan Lim Keng Hock from the employment of SSH the said Johnathan Lim Keng Hock incorporated each of the 1st and 2nd defendants respectively and utilized the said confidential information in establishing the 1st and 2nd defendants' business in Singapore.

The statement of claim goes on to say that by virtue of such deliberate infringements the plaintiffs have suffered substantial loss and damage, and that the defendants are making profits at the expense of the plaintiffs. In para. 20, the plaintiffs ask for additional statutory damages in these terms:

> 20. Having regard to the flagrancy of the infringements and to the fact that the infringements enable the 1st and 2nd defendants to compete unfairly in trade with the plaintiffs, damages for infringement of the plaintiffs' copyright would not be an adequate remedy and the plaintiffs are entitled to and do claim an award of additional statutory damages.

On 7 July 1990 the defendants, without first filing their defence, applied to Court for further and better particulars. This was preceded by a written request for particulars made earlier by the defendants' solicitor which request was refused by the plaintiffs. On 13 August 1990, the Assistant Registrar refused the application. On 16 August 1990 the defendants filed a Notice of Appeal, and that was the matter that came before me.

In the meantime on 13 September 1990, following the refusal of the application by the Assistant Registrar, the defendants filed their amended defence and counterclaim (amended pursuant to O. 20 r. 3). On 24 October 1990, the defendants filed a rejoinder following the reply and defence to counterclaim filed by the plaintiffs.

First Set of Particulars

The further and better particulars asked for by the defendants fall under four groups and I shall deal with each in turn. The first set of particulars requested relate to the subsistence and ownership of the copyright in the industrial drawings and they are these:

(i) the authors who designed the industrial drawings;

(ii) nationalities and relationship of the authors to the plaintiffs;

(iii) the date and place and country where each of the industrial drawings was first published;

(iv) the matters relied upon by the plaintiffs to establish that they were the owners of the alleged copyright in each of the industrial drawings.

In the hearing before the Assistant Registrar as well as before me, Counsel for the plaintiffs made the point that the application for particulars was made even before the defendants had filed their defence and that was improper. Counsel urged me to bear in mind O. 18 r. 12(5) of the RSC which provides that an order for further and better particulars "shall not be made before service of the defence unless, in the opinion of the Court, the order is necessary or desirable to enable the defendant to plead or for some other special reason."

As stated above, in para. 5 of the statement of claim, the plaintiffs have expressly stated that the industrial drawings were designed by members of the plaintiffs' design office all of whom were at all material times employed by the plaintiffs.

Under the Copyright Act (hereinafter called "the Act"), the general rule is that the author of a literary, dramatic, musical or artistic work "shall be entitled to any copyright subsisting in the work. " However, under s. 30(6) of the Act where such a work is made pursuant to a contract of employment the employer shall be entitled to the copyright.

Under s. 130(1) of the Act it is provided that copyright shall be presumed to subsist in the work to which the action relates if the defendant does not put in issue the question whether copyright subsists in the work. And where the subsistence of the copyright is established, the plaintiff shall be presumed to be the owner of the copyright unless the defendant puts in issue the question of his ownership. It is also pertinent to note that under O. 18 r. 7(3) a party is not required to plead any fact if it is presumed by law to be true "unless the other party has **specifically denied it in his pleading.**"

I would observe that the wording of the statement of claim on this aspect of the claim follows rather closely the wording used in precedent No 59 (on p. 535) of *Atkin's Encyclopedia of Court Forms in Civil Proceedings* [1990] Vol. 12. The statement of claim clearly sets out the basis upon which the plaintiffs claim ownership of the copyright in the industrial drawings. No sufficient reasons have been given why the defendants could not have filed their defence before asking for particulars. It has also not been shown that the defendants would be prejudiced or embarrassed in his pleadings if particulars should not be furnished before defence. On this ground alone the Assistant Registrar was right to refuse this set of particulars requested (and indeed of all the other particulars as well) and I upheld his decision.

The defendants relied upon two cases. First was *Roban Jig & Tool Co. Ltd. v. Taylor* [1979] FSR 130. That was a case where the statement of claim and the particulars furnished (after defence was filed) showed that the drawings were prepared by independent contractors for the plaintiffs and neither the statement of claim nor the particulars furnished pleaded to any form of legally valid assignment. There, the English Court of Appeal held that in those circumstances the plaintiffs had no cause of action and the action was accordingly struck out.

The second case relied upon was *PJ Holdings Australia Pty. Ltd. v. Hughes* [1979] ALR 538, where the plaintiff, a company, claimed ownership to a certain building plan. The defence filed did not admit plaintiff's claim to ownership. Before the hearing of the application for

particulars, the plaintiff furnished the particulars. The Judge there said that he would have ordered particulars to be given if they had not been furnished because "the statement that the plaintiff (was) the author of the plan in question (did) not satisfactorily state facts giving rise to the ownership of copyright, as the plaintiff (was) a private company." It was clear that in *PJ Holdings* particulars had to be furnished because a company could never be the author of a work; something more must be pleaded to show how the company could have become the owner.

It would have been clear that both these cases, *Roban Jig and PJ Holdings*, do not support the defendants' claim that they are entitled to the particulars. First, the claim to ownership of copyright in those two cases was not on the basis that the work was created by employees in the course of employment. Second, the defendants in the two cases applied for particulars only after they had filed their defence.

Further, I was of the view that what is asked for relates to evidence which should only be given at the trial. What needs to be pleaded are facts, not evidence. This is early provided in O. 18 r. 7(1) and facts need only be stated in summary form. A plaintiff need not plead the evidence by which those facts are to be proved.

In a sense this appeal does raise the familiar issue of whether the particulars requested should be regarded as material facts or as evidence and I recognise that the line between the two is often very difficult to draw. Before me Counsel for the defendants submitted that what the defendants require the plaintiffs to plead are these:

(i) authorship of the industrial drawings;

(ii) details of employment contract; and

(iii) assignment of the industrial drawings by the authors to the plaintiffs.

It seemed to me that (i) and (ii) relate to matters of details and evidence. These are matters which the plaintiffs will have to prove at the trial if they are to succeed since the questions of the subsistence of copyright and the ownership thereof have been put in issue in the defence filed (subsequently to the refusal of the Assistant Registrar). As for (iii) the question of assignment does not arise because by virtue of s. 30(6) of the Act, copyright in works created by an employee in the course of employment automatically vests in the employer. There is no need for any instrument of assignment to be executed by the author (that is, employee) in favour of the employer. This fact differentiates the present case from *Roban Jig* and *PJ Holdings*.

Second Set of Particulars

I turn next to the second set of particulars requested. This relates to para. 11 of the statement of claim. Here the defendants require the plaintiffs to state the number of industrial machines which were manufactured and sold by the plaintiffs worldwide. Defendants' Counsel submitted that if more than fifty such machines had been manufactured and sold, then the industrial drawings are not protected under the Copyright Act, as they are capable of being protected under the UK Patents and Designs Act 1907 where the period of protection is only five years.

Without going too much into the law governing designs, this point can be disposed of fairly briefly. Of course, designs registered in the United Kingdom are protected in Singapore under our United Kingdom Designs (Protection) Act. As I understand it, only features of shape, configuration, pattern or ornament applied to any article by an industrial process or means,

being features which in the finished article appeal to and are Judged solely by the eye, are capable of being registered as a design under the UK Registered Designs Act 1949. Design protection only operates to protect the appearance of articles, not the way they are made or in which they operate. Parker J put it this way in *Pugh v. Riley Cycle Co. Ltd.* [1912] 1 Ch 613 at 619:

> A design, to be registrable under the Act, must be some conception or suggestion as to shape, configuration, pattern, or ornament. It must be capable of being applied to an article in such a way that the article to which it has been applied will show to the eye the particular shape, configuration, pattern, or ornament the conception or suggestion of which constitutes the design. In general any application for registration must be accompanied by a representation of the design - that is, something in the nature of a drawing or tracing by means of which the conception or suggestion constituting the design may be imparted to others. In fact, persons looking at the drawing ought to be able to form a mental picture of the shape, configuration, pattern or ornament of the article to which the design has been applied. A conception or suggestion as to a mode or principle of construction, though in some sense a design, is not registrable under the Act. Inasmuch, however, as the mode or principle of construction of an article may affect its shape or configuration, the conception of such a mode or principle of construction, may well lead to a conception as to the shape or configuration of the completed article, and a conception so arrived at may, if it be sufficiently definite, be registered under the Act.

I agree with the plaintiffs' submission and it is obvious that the industrial equipment in question which are reproduced from the industrial drawings do not have eye appeal. They are purely functional equipment used for heavy industrial welding. The industrial drawings have really nothing to do with design in the sense as described above and therefore the Assistant Registrar was quite right in refusing the application for those particulars as the particulars asked for are totally irrelevant to the issue raised in statement of claim.

Third Set of Particulars

The third set of particulars requested relates to para. 15(h), (k), (l) and (m) of the statement of claim. At the hearing before me, Counsel for the defendants expressly abandoned the request under para. 15(h). As for the others he did not really make any serious arguments on them. His written skeletal did not even touch on them. As I saw it, what are stated in para. 15(k), (l) and (m), which I have quoted above, are clear enough. In my view the particulars which the defendants requested relate to details and are matters of evidence to be adduced at the trial.

Fourth Set of Particulars

The final set of particulars which the defendants sought relates to para. 20 of the statement of claim. They want the plaintiff to state "full particulars of the grounds and heading" under which the plaintiffs claim for additional damages. Here, the defendants must fail for two reasons. First, in my opinion, the particulars upon which the plaintiffs are claiming for additional damages are set out in paras. 15 to 19 of the statement of claim. These paragraphs set out sufficient facts to show the flagrancy of the infringement. It is clear to me that the plaintiffs are asking for additional damages because the infringements by the defendants were and are not accidental or innocent but deliberately done with the view of making profit at the expense of the plaintiffs. As Dunn J said in *PJ Holdings Australia Pty. Ltd. v. Hughes* at p. 541:

> I should say that I accept that it will not always be necessary specially to plead facts which are relied on in aggravation of damages. On occasions, to plead the constitutive facts which give rise to the cause of action (for example, in a case of trespass to land or person,

or a case of defamation) will suffice to indicate that, if those facts are proved, an award of aggravated or exemplary damages will be appropriate. In *Williams v. Settle, supra,* the facts as disclosed in the report suggest that the statement of claim must have asserted facts which, if proved, would establish scandalous conduct and a flagrant breach of copyright by the defendant.

Second, there is no need for the plaintiffs to furnish such particulars. This was established in the case *Broome v. Cassell & Co. Ltd.* [1971] 2 QB 354. I must, however hasten to add that since 1972 the English practice has been altered, and the effect of *Broome's* case was overridden by a 1972 amendment (O. 18 r. 8(3)) which expressly provides that "a claim for exemplary damages must be specifically pleaded together with the facts on which the party pleadings relies." Singapore has not introduced a similar rule into our RSC.

One final comment. In dismissing the appeal, I added that that was without prejudice to the defendants applying afresh for further and better particulars as they deem fit. This was intended to make clear that the dismissal of the appeal did not preclude the defendants from making another application for further and better particulars which was warranted by the pleadings.

Also found at [1991] 2 CLJ 1642